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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,538	05/10/2002	Jonathan Quinton Kerr	FHW-099US	6206
959	7590	02/17/2004		
LAHIVE & COCKFIELD, LLP. 28 STATE STREET BOSTON, MA 02109			EXAMINER MARMOR II, CHARLES ALAN	
			ART UNIT	PAPER NUMBER
			3736	

DATE MAILED: 02/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/031,538

Applicant(s)

KERR, JONATHAN QUINTON

Examiner

Charles A. Marmor, II

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 May 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Drawings

1. The drawings are objected to because in Figure 7, reference sign “6” apparently should read --5--. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claim 1 is objected to because of the following informalities:
- a. In line 4, “the” (first occurrence) apparently should read --a--.
 - b. In line 5, “the” (first occurrence) apparently should read --a-- and
“material” apparently should read --film--.
 - c. In line 6, “the alternative” apparently should read --an opposite--.
- Appropriate correction is required.

3. Claim 2 is objected to because of the following informalities: in line 2, --testing-- apparently should be inserted before “apparatus”. Appropriate correction is required.

4. Claim 4 is objected to because of the following informalities: in line 3, --testing-- apparently should be inserted before “apparatus”. Appropriate correction is required.

Art Unit: 3736

5. Claims 6-8 are objected to because of the following informalities: in line 1, --of barriers-
- apparently should be inserted after “pack”. Appropriate correction is required.

6. Claim 9 is objected to because of the following informalities:

a. In line 4, “the” (first occurrence) apparently should read --a--.

b. In line 5, “whereby” apparently should read --wherein--.

c. In line 6, “may” apparently should read --is adapted to--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 4-6, 9 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 4, the claim language renders the claim indefinite. Specifically, it is unclear whether each ring of the series has a perimeter consistent with that of the probe head or whether the series of rings forms a perimeter consistent with that of the probe head.

Regarding claim 5, it is unclear which backing sheet is being referred to in lines 2 and 3 of the claim.

Regarding claim 9, the claim language renders the claim indefinite. Specifically, at lines 4-5, it is unclear whether the pieces or the probe head have at least one sterile surface.

Regarding claim 10, the claim language renders the claim indefinite. Specifically, the limitation "the surface of each piece... opposing the at least one sterile surface" is indefinite. It is unclear how many surfaces each piece has, and if each piece were to have a plurality of surfaces, what surface would be in opposition to the sterile surface(s).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-7, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brady ('057) in view of Makita et al. ('058).

Brady teaches a cover for the prism of an applanation tonometer. The cover **10** is a disposable and sterile sheet. The cover **10** includes a first backing sheet **34**, a barrier **22** of substantially transparent film (col. 4, lines 24-28) having dimensions comparable to those of the eye-contacting surface **12** of the tonometer probe **14**, and a second backing sheet **32** to which the barrier and the first backing sheet are adhered. The barrier is removably attached to the first sheet by friction when pressed between the two backing sheets. A surface of the barrier adjacent the first backing sheet is sterile. The opposite surface of the barrier is not formed of an adhesive material; however, said opposite surface is provided with a peelable adhesive upon engagement with an adhesive material on the second backing sheet (col. 4, lines 55-60). A colored marker ring for locating the head of the probe will be provided on the first backing sheet by the contrast

Art Unit: 3736

inherently formed by the positioning aperture **36** disposed against the first backing sheet. The barrier is provided with tabs **28** for easy removal of the barrier. Brady teaches all of the limitations of the claims except that there are a plurality of covers provided on a perforated sheet to provide a pack of barriers.

Makita et al. teach a pack **30** of plurality of probe covers **20** disposed on a perforated **31** sheet.

It would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to provide a plurality of sterile probe covers similar to those of Brady on a perforated sheet in view of the teachings of Makita et al. for simplified manufacturing, convenient dispensing, and easy detachment of single covers as desired without requiring use of cutting tools.

11. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brady ('057) in view of Makita et al. ('058) as applied to claims 1 and 7 above, and further in view of Segal et al. ('914). Brady, as modified by Makita et al. hereinabove, teaches all of the limitations of the claim except that the tabs are provided with an adhesive substance for retaining the barrier onto the head of the probe. Segal et al. teach a disposable cover **100** for a tonometer having tabs **130** with adhesive substances for securely coupling the cover to an applanation head **20** of a tonometer (col. 5, lines 6-27). It would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to provide the tab members of probe covers similar to those of Brady, as modified by Makita et al., with an adhesive material in view of the

Art Unit: 3736

teachings of Segal et al. in order to provide a more secure connection of the probe cover to the probe head.


Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Canfield et al. ('454) teach a disposable probe cover for a tympanic thermometer. Price ('590) teaches an eyelid closure patch. Stark et al. ('025) teach a cover for a stethoscope head.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles A. Marmor, II whose telephone number is (703) 305-3521. The examiner can normally be reached on M-TH (7:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (703) 308-3130. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Charles A. Marmor, II
Primary Examiner
Art Unit 3736

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February 11, 2004